



Paper No. 6

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OFFICE OF PETITIONS

In re Application of:
Barry, et al.
Application No.: 09/748,804
Filed: 27 December, 2000
Docket No. : 9D-DW-19349

DECISION ON PETITION

This is a response to the petition filed on 30 January, 2002, for withdrawal of the notice of abandonment and treated appropriately under 37 C.F.R. §1.181,¹ or alternatively a petition to revive the above-identified application under 37 C.F.R. §1.137(b).²

¹ The regulations at 37 C.F.R. §1.181 provide:

§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

For reasons set forth below, the petition under 37 C.F.R. §1.181 is **DISMISSED**, and the petition under 37 C.F.R. §1.137 (b) is **GRANTED**.³

The application became abandoned after the Petitioner failed to reply properly and timely to a Notice of Missing Parts mailed on 8 February, 2001, with response due (absent extension of time) on or before 8 April, 2001.

A review of the record indicates that:

- Petitioner having failed to file a timely and proper reply to the Notice of Missing Parts, the application went abandoned after midnight 8 April, 2001;
- No Notice of Abandonment was mailed;
- an Associate Power of Attorney/Change of Address was filed on 18 December, 2001;
- a reply to the Notice of Missing Parts was filed 30 January, 2002, contemporaneously with the instant petitions.

The courts have determined the construct for properly supporting an a request to withdraw a holding of abandonment.⁴

Petitioner states that his file does not contain the Notice of Missing Parts, and that fact supports his contention that the Notice was not received. However, the Notice was mailed to the Applicant's address of record ten (10) months before the filing of the Change of Address.

Moreover, Petitioner provides no docketing data or mail logs which might support Petitioner's position. Petitioner's argument has no basis in fact or law and is unpersuasive.

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulyer.

Withdrawal of the holding of abandonment is not appropriate and hereby is **dismissed**.

Petitioner's petition under 37 C.F.R. §1.137(b) (with fee) is accompanied by a reply to the Notice, the surcharge and the statement of unintentional delay.

Therefore, the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is being forwarded to OIPE for processing of:

- the reply to the Notice of Missing Parts; and
- the Associate Power of Attorney and Change of Correspondence Address.

Thereafter, the application will be forwarded for examination in due course.

³ Pursuant to Petitioner's instructions, the petition fee (\$1,280.00) and CPA filing fee (\$740.00) are charged to Deposit Account 05-0225.

⁴ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon, Jr.', with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy.